

Remarks

In section 1 of the Office action, informalities were identified in claims 1 and 4. These informalities have been duly corrected.

Section 102

The first issue is whether the applicant's claims 1 and 5-8 are anticipated by a cited reference. A review of the teachings of the reference indicates that it does not anticipate the pending claims.

A claim is anticipated only if each and every element as set forth in the claim is found in a single cited art reference. See Verdegaal Bros. v. Union Oil of California, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. See Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). To render a claim not novel, the elements in the cited reference must be arranged as required by the claim. See In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990).

In the present instance, the applicant has claimed a device for testing integrated circuits. Like other prior test devices, the claimed device includes a base, a socket within the base for testing integrated circuit devices, a lid that closes over the base, and a pressure plate mounted within the lid. Also part of this claimed device are "two cam levers each mechanically linked to opposing sides of the lid". This claimed element not only specifies that two cam levers are required, it also specifies the configuration of these levers, namely on opposing sides of the lid. This configuration gives the pressure plate a balanced force when pressure is applied to the device under test.

The applicants claimed configuration is not disclosed in the cited reference. In the Gallagher et al.

reference, the two elements labeled as "cam" are one the same side of the lid of the device. (see element number 54 in Fig. 2, Fig. 3). This is simply not the configuration claimed by the applicant.

Under patent law, a reference may only anticipate a claim if the reference teaches the identical claimed organization of claim elements. The cited reference fails to teach the claimed organization. For this reason the present rejection should be reconsidered and withdrawn.

Obviousness

The second issue is whether the applicants' claims are rendered obvious in light of a combination of cited references and thus are not allowable under 35 USC § 103. An analysis of the cited references warrants reconsideration of the rejection.

No proper teaching to combine is cited

The obviousness rejections should be reconsidered because there is no proper teaching for the combination of the cited references. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine the prior art references." In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (internal citations omitted). "The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there

is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In applying this law to the present claims, a finding of obvious should be reconsidered.

No clear and particular teaching to combine exists

The law requires a clear and particular teaching to be found in the cited references. Such a teaching must come from the references. In addition, broad conclusory statements are deemed not sufficient. However such broad conclusory statements are all that are proffered in the present Office action.

In section 5 of the Office action (and by reference section 7), the combination of Gallagher et al. and Yoshizaki is suggested "in order to make sure that the leads of an integrated circuit are all in contact with pins of a socket". However nothing in Gallagher et al. is cited as making this combination necessary. Since nothing in Gallagher et al. would indicate visual inspection is required, then there would be no motivation to make the cited combination.

In section 6 of the Office action (and by reference section 7) the combination of Gallagher et al. and Mayer is suggested "to provide Gallagher et al. to have the release lever, as taught by Mayer for better connection." This again is wholly insufficient. From the Office action it is not clear what requires a better connection, and what reference cites such a deficiency. Instead, there is every indication that Gallagher et al. has taught a fully functional device in which the parts are adequately connected. Absent such a teaching, the device would simply not function.

The leaf spring and bail elements taught by Gallagher et al. already provide a means for locking the cam into a fixed position. When elements have already been provided to serve a function, there is no reason to modify a

device to achieve that function. This appears to be what the Office action proposes.

In both combinations of references, the teaching to combine is drawn not from the cited reference, but instead from using the applicant's own claims as a template to make this combination. This is per se impermissible to establish a prima facie case of obviousness. This provides an independent reason for withdrawing the obviousness rejection.

The asserted references do not render obvious the applicant's claims

Even if the references are combined, this combination does not render obvious the applicant's claims. To render a claim obvious, the prior art reference must disclose all of the claim limitations. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).

In all of the above rejections, Gallagher et al. is cited to teach a test device including cams. While Gallagher does teach the use of cams, Gallagher discloses only one configuration of these cams, namely a configuration in which the cams are on a single side of the lid. However the applicants independent claims 1 and 9 require a specific configuration, namely the use of cam levers on either side of the lid. As already noted, Gallagher et al. simply does not teach this claimed configuration. This provides another independent reason to reconsider the instant obviousness rejections.

Conclusion

The applicants respectfully request reconsideration in light of the submitted remarks and amendments. A notice of allowance is earnestly solicited. If any matter relating to this case needs to be discussed please call our office at (408) 297-9733 between 9 a.m. and 5 p.m. Pacific time.

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Signed: *Sally Azevedo*
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Respectfully submitted,

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